

DEC 28 2005

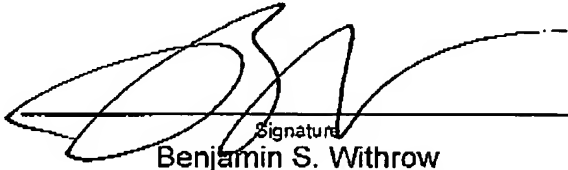
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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		7000-062	
I hereby certify that this correspondence is being transmitted via facsimile on the date indicated below to: Examiner: Hossain, Tanim M. Art Unit: 2145 Fax Number: 571-273-8300 on <u>December 28, 2005</u> Signature <u>Rebecca A. Rooks</u> Typed or printed name <u>REBECCA A. ROOKS</u>		Application Number 10/034,431	Filed 12/27/2001
		First Named Inventor Steve J. McKinnon	
		Art Unit 2145	Examiner Hossain, Tanim M.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature Benjamin S. Withrow	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Typed or printed name 919 654-4520	
<input checked="" type="checkbox"/> attorney or agent of record. 40,876 Registration number _____		Telephone number December 28, 2005	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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CENTRAL FAX CENTER****DEC 28 2005****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Steve J. McKinnon et al.
Serial No. 10/034,431
Filed: 12/27/2001
For: **DYNAMIC PRESENCE MANAGEMENT**

Examiner: Hossain, Tanim M.
Art Unit: 2145

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

The current remarks provide a succinct and focused set of arguments for which review is being requested and accompany the concurrently filed Notice of Appeal. Appellant requires a one-month extension of time and requests that this be considered a petition therefor. Appellant has enclosed a Credit Card Form authorizing payment of \$620.00 to cover the cost of the Notice of Appeal and the extension of time fee. If any additional fees are required in association with this response, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

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REMARKS

Appellant files the Request for a Pre-Appeal Brief Review of the application so that the panel of Examiners may determine whether the Office Actions of record adequately establish two things. Appellant initially queries whether the Patent Office has adequately established anticipation under 35 U.S.C. § 102. Appellant secondly queries whether the Patent Office has established a proper motivation to combine the references in an obviousness rejection.

A. Boyer Does Not Anticipate the Claims

Anticipation is a strict standard that requires that all the elements of the claim be present in the reference and also arranged as claimed. MPEP § 2131. The burden is on the Patent Office to show anticipation and, to date, the Patent Office has been unable to show that all the elements are arranged as claimed.

The claims recite that the service logic is created in the presence detection system. In contrast, Boyer teaches the service logic created within the SPFS. Appellant has presented a more complete analysis in the Response filed November 4, 2005, page 2, line 19-page 3, line 5. The Advisory Action asserts that "service logic is created throughout the system at various locations. When a state change is recognized by a keystroke, as a broad example, service logic is created to alert the system of this state change." (Advisory Action of November 22, 2005, continuation page, lines 1-3). However, this assertion ignores Appellant's definition of service logic presented in paragraph 0005 of the specification. The Patent Office is not free to ignore definitions for claim terms when the inventor has defined the claim term in the specification.

Appellant has also addressed the possibility that the Patent Office may construe the SPFS to be a part of the presence detection system. If this construction is correct (a point which Appellant does not concede), then Boyer does not teach providing the service logic from the presence detection system to the associated presence service as is recited in the claims. This argument is well summarized in the Response filed November 4, 2005, page 3, line 6-page 4, line 8.

In short, the Patent Office has not shown that service logic is generated by the presence detection system and then provided to the associated presence service. Since Boyer does not teach these claim elements arranged as claimed, Boyer does not anticipate the claims.

B. The Combination Is Not Properly Supported

The Federal Circuit acknowledges that the Patent Office may use a number of different sources to find a motivation to combine references in an obviousness rejection. However, to combat hindsight reconstruction, the Federal Circuit requires that the Patent Office support the motivation to combine references with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Appellant argued in the Response filed November 4, 2005, page 4, line 16-page 5, line 7 that the Patent Office had not provided the required evidence. The Patent Office, to date, has not provided the evidence required by the Federal Circuit to prove that the Patent Office is not relying on improper hindsight reconstruction. The Advisory Action does assert that the use of a GPS system within presence systems is eminently well known to one of ordinary skill in the art at the time of the invention. Again, this statement is an unsupported assertion on the part of the Patent Office and does not comply with the evidentiary standards set forth by the Federal Circuit. Since the Patent Office has not provided the required evidence, the combination is improper, and the Patent Office has not established obviousness.


Appellant requests that the panel of Examiners review the arguments previously presented and determine whether the Patent Office has established anticipation and a proper motivation to combine the references. If the panel determines that either of these requirements has not been met, Appellant requests withdrawal of the rejection and claim allowance.

CERTIFICATE OF TRANSMISSION I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:
Examiner: <u>Hossain, Tanim M.</u> Art Unit: <u>2145</u> Fax: <u>571-273-8300</u>
<u>REBECCA A. ROOKS</u> Name of Sender
<u>Rebecca A. Rooks</u> Signature
<u>12-28-05</u> Date of Transmission

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:


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Date: December 28, 2005
Attorney Docket: 7000-062